

**Notice of Allowability**

Application No.

10/505,257

Applicant(s)

BUDHU ET AL.

Examiner

Art Unit

Yong Chu

1626

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address--

All claims being allowable, PROSECUTION ON THE MERITS IS (OR REMAINS) CLOSED in this application. If not included herewith (or previously mailed), a Notice of Allowance (PTOL-85) or other appropriate communication will be mailed in due course. **THIS NOTICE OF ALLOWABILITY IS NOT A GRANT OF PATENT RIGHTS.** This application is subject to withdrawal from issue at the initiative of the Office or upon petition by the applicant. See 37 CFR 1.313 and MPEP 1308.

1. ☒ This communication is responsive to 05/02/2007.
2. ☒ The allowed claim(s) is/are 1-4,6-15 and 29 (renumbered as 1-15).
3. ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some\* c) ☐ None of the:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\* Certified copies not received: \_\_\_\_\_.

Applicant has THREE MONTHS FROM THE "MAILING DATE" of this communication to file a reply complying with the requirements noted below. Failure to timely comply will result in ABANDONMENT of this application.

**THIS THREE-MONTH PERIOD IS NOT EXTENDABLE.**

4. ☐ A SUBSTITUTE OATH OR DECLARATION must be submitted. Note the attached EXAMINER'S AMENDMENT or NOTICE OF INFORMAL PATENT APPLICATION (PTO-152) which gives reason(s) why the oath or declaration is deficient.
5. ☐ CORRECTED DRAWINGS (as "replacement sheets") must be submitted.
- (a) ☐ including changes required by the Notice of Draftsperson's Patent Drawing Review (PTO-948) attached
- 1) ☐ hereto or 2) ☐ to Paper No./Mail Date \_\_\_\_\_.
- (b) ☐ including changes required by the attached Examiner's Amendment / Comment or in the Office action of Paper No./Mail Date \_\_\_\_\_.
- Identifying indicia such as the application number (see 37 CFR 1.84(c)) should be written on the drawings in the front (not the back) of each sheet. Replacement sheet(s) should be labeled as such in the header according to 37 CFR 1.121(d).
6. ☐ DEPOSIT OF and/or INFORMATION about the deposit of BIOLOGICAL MATERIAL must be submitted. Note the attached Examiner's comment regarding REQUIREMENT FOR THE DEPOSIT OF BIOLOGICAL MATERIAL.

**Attachment(s)**

- |  |   |
|--|---|
| 1. <input type="checkbox"/> Notice of References Cited (PTO-892)   | 5. <input type="checkbox"/> Notice of Informal Patent Application                     |
| 2. <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)   | 6. <input type="checkbox"/> Interview Summary (PTO-413),<br>Paper No./Mail Date _____ |
| 3. <input checked="" type="checkbox"/> Information Disclosure Statements (PTO/SB/08),<br>Paper No./Mail Date <u>05/02/2007</u> | 7. <input checked="" type="checkbox"/> Examiner's Amendment/Comment                   |
| 4. <input type="checkbox"/> Examiner's Comment Regarding Requirement for Deposit<br>of Biological Material                     | 8. <input checked="" type="checkbox"/> Examiner's Statement of Reasons for Allowance  |
|  | 9. <input type="checkbox"/> Other _____   |

## **DETAILED ACTION**

Claims 1-4, 6, 8-11, 14, 15, and 29 are pending in this application.

### ***Information Disclosure Statement***

Applicants' Information Disclosure Statement, filed on 05/02/2007, has been considered. Please refer to Applicant's copy of the PTO-1449 submitted herewith.

### ***Response to Amendment***

The Amendment by Applicants' representative Raynard Yura dated on 05/02/2007 has been entered.

### ***Response to Amendments***

#### **Unity of Invention**

The scope of the invention has been revised and the amended claims 1-4, 6-15 and 29 will be examined on the merits.

#### **Rejection under 35 U.S.C. §101/ §112, 1<sup>st</sup> Paragraph**

The Declaration under 37 CFR 1.132 filed 05/02/2007 is sufficient to overcome the rejection of claims 1-4, 6, 8-11, 14, 15 and 29 for lacking a credible asserted utility based upon the ligand binding to S1P1 IC<sub>50</sub> and EC<sub>50</sub> data. Therefore, the rejections have been withdrawn.

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**Rejection under 35 U.S.C. §103(a)**

Applicant's submission of the Terminal Disclaimer and Statement Establishing Common Ownership To disqualify U.S. Patent No. 6,437,165 as 102(e) Prior Art Under 35 U.S.C. §103(c) pursuant to MPEP § 706.02(1)(2) is sufficient to overcome the rejection of claims 1-4, 6, 8-11, 14, 15 and 29 under 35 U.S.C. §103(a).

**Rejection under Obviousness-type of Double Patenting**

Applicant's submission of the Terminal Disclaimer is sufficient to overcome the rejection of claims 1-4, 6, 8-11, 14, 15 and 29 under Obviousness-type of Double Patenting.

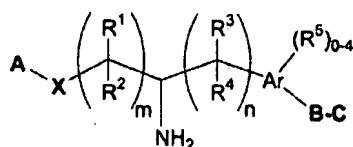
***Examiner's amendment***

An examiner's amendment with authorization from Applicants representative Mr. Raynard Yura dated on 07/19/2007 to the record appears below. Should the changes and/or additions be unacceptable to applicant, an amendment may be filed as provided by 37 CFR 1.312. To ensure consideration of such an amendment, it MUST be submitted no later than the payment of the issue fee.

Delete claims 16-17, and 28.

***Reasons for Allowance***

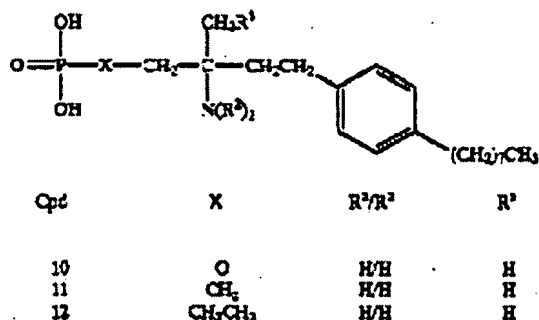
The present invention is directed to a compound of the formula (I)



, wherein the substituents are defined as in claim 1.

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The closest prior art of record is U.S. Patent 6,437,165 (the '165 patent). The



'165 patent discloses compounds for the same utility as the instant application. However, applicant's filing of TD and the Statement provoking 103(c) disqualified this prior art. Therefore, claims 1-4, 6-15 and 29 are allowed.

### **Telephone Inquiry**

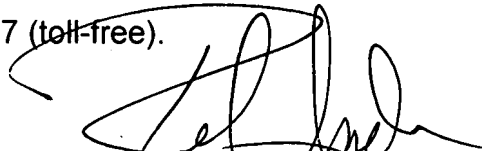
Any inquiry concerning this communication or earlier communications from the examiner should be directed to Yong Chu whose telephone number is 571-272-5759. The examiner can normally be reached on 7:00 am - 3:30 pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Joseph K. McKane can be reached on 571-272-0699. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only.

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For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).



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